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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Bart C. Thielges

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07/03/2008

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EXAMINER

LOFTIS, JOHNNA RONEE

ART UNIT

PAPER NUMBER

3623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/938,265	<b>Applicant(s)</b> THIELGES ET AL.	
	<b>Examiner</b> JOHNNA R. LOFTIS	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-21 and 42-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-21 and 42-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The following is a non-final office action upon examination of application number 09/938,265. Claims 8-21 and 42-56 are pending and have been examined on the merits discussed below.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 8-21 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that the claimed invention is performed automatically over the Internet. Previous rejections have been modified to address the newly amended claims.

3. With respect to claim 15, Examiner has upheld previous rejection in view of Halbritter, since arguments are based on claim 8 which has been addressed below.

4. Regarding claim 42, Harrison teaches automatic routing wherein unassigned work orders are automatically assigned to available technicians. Inherently in this process, each technician is successively reviewed, including their work status, until an appropriate technician is identified. Previous rejections are upheld.

5. With respect to claims 49-56, Examiner asserts that while the claims are directed to a level of urgency, the Jones reference teaches an escalation level that corresponds to the "urgency" of addressing a trouble ticket. The prior rejections are upheld.

6. Based on Supreme Court precedent and recent Federal Circuit decisions, new rejections under 35 USC 101 have been introduced.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 42-56 are rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions. The Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

9. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 42-56 are non-statutory since they may be performed within the human mind.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al, US 6,990,458.

As per claim 8, Harrison et al teaches receiving a digitized service request from the service requestor (column 3, lines 11-65 – subscribers submit a service request using e-mail, telephone, or several other means of communication); storing the digitized service request (column 4, lines 9-27 – service request is entered into the service request input terminal); and transmitting the digitized service request to a computer capable of displaying the digitized service request, the computer being accessible to a receiver wherein the receiver is not the service requestor (column 4, lines 9-27 – service request (communicated from the subscriber to the service representative) is entered into the service request input terminal, processed and a graphical representation of the request is created).

It was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of receiving and storing the digitized service request gives just what one would expect from the manual step as shown in Harrison et al. In other words, there is no

enhancement found in the claimed step other than the known advantage of increased speed. The end result is the same as compared to the manual method.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the step of receiving and storing the digitized service request because this would speed up the receiving and storing step which is a purely known and expected result from automation of what is known in the art.

Further, it would have been obvious to a person of ordinary skill in the art at the time of the invention to enter the digitized service request into a web-based interface over the Internet because the advantage of communicating over the Internet allows users to communicate anywhere in the world that has access to the Internet and one of ordinary skill in the art would have recognized that the results of automating the steps over the Internet were predictable.

As per claims 9-14, Harrison et al teaches the receiver is a service representative and/or technician, but does not expressly teach the receivers recited in claims 9-14; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106.

As per claim 16, Harrison et al teaches the computer displays a visual portion of the digital service request (column 4, lines 9-27 – service request is entered into the service request input terminal, processed and a graphical representation of the request is created).

As per claim 17, Harrison et al teaches the computer is a personal computer (column 3, lines 11-29 – input terminal is a computer).

As per claim 18, Harrison et al teaches the digitized service request is transmitted over the Internet (column 3, lines 35-48 – communication takes place using email, wireless computer, etc)

As per claim 19, Harrison et al teaches the digitized service request is transmitted over a telephony network (column 3, lines 35-48 – communication takes place using standard telephone).

As per claims 20 and 21, Harrison et al teaches the service requester is a subscriber, but does not expressly teach the requestors recited in claims 20 and 21; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106.

As per claim 42, Harrison et al teaches receiving a service request from a service requestor (column 3, lines 11-65 – subscribers submit a service request using e-mail, telephone,

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or several other means of communication), the service request being transmitted to the system (column 4, lines 9-27 – service request is entered into the service request input terminal); identifying with the system an appropriate technician to respond to the request; and relaying at least part of the service request from the requestor to the technician (column 4, lines 28-37 – service request is entered; column 6, lines 6-16 – automatic dispatch of service requests to available technicians). While Harrison et al does not explicitly teach the system being associated with property management these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per claim 44, Harrison et al teaches the service requester is a subscriber, but does not expressly teach the requestor is a tenant; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.



As per claim 45, Harrison et al teaches receiving a service request from a service requestor (column 3, lines 11-65 – subscribers submit a service request using e-mail, telephone, or several other means of communication), the service request being transmitted to the system (column 4, lines 9-27 – service request is entered into the service request input terminal); identifying, with the system, a technician by successively reviewing increasingly more general descriptions until an appropriate technician is identified; and relaying at least part of the service request from the service requestor to the technician identified (column 4, lines 28-37 – service request is entered; column 6, lines 6-16 – automatic dispatch of service requests to available technicians). While Harrison et al does not explicitly teach the system being associated with property management these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106.

As per claim 46, Harrison et al teaches the service requester is a subscriber, but does not expressly teach the requestor is a tenant; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the

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prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per claim 47, Harrison et al teaches receiving a service request from a service requestor (column 3, lines 11-65 – subscribers submit a service request using e-mail, telephone, or several other means of communication), the service request being transmitted to the system (column 4, lines 9-27 – service request is entered into the service request input terminal); identifying, with the system, a technician by successively reviewing increasingly more general descriptions until an appropriate technician is identified; and relaying at least part of the service request from the service requestor to the technician identified (column 4, lines 28-37 – service request is entered; column 6, lines 6-16 – automatic dispatch of service requests to available technicians). While Harrison et al does not explicitly teach the system being associated with property management these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per claim 48, Harrison et al teaches the service requester is a subscriber, but does not expressly teach the requestor is a tenant; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same

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regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al, US 6,990,458, in view of Halbritter et al, US 7,022,017.

As per claim 15, Harrison et al teaches the communication of the service request using a computer but does not teach an audio portion of the digital service request. Halbritter et al, however, teaches a service request system wherein service requests are received from kiosk terminals and transmits data regarding service request in the form of audio, video, etc., for further processing (column 3, lines 26-43). Official notice is taken that it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate audio messages communicating service request information into Harrison et al as another means to inform appropriate personnel about service requests. The audio portion would benefit technicians on the job or en route to a job wherein they could listen to pertinent information regarding a service request without having to actually view a service request.

12. Claims 43 and 49-56 rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al, US 6,990,458, in view of Jones, US 6,219,648.

As per claim 43, Harrison et al teaches identifying the appropriate associate to fulfill the request but does not teach the identifying step is a hierarchical tree traversal search through successive hierarchical levels towards the root of the hierarchical tree. However, the search

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utilized in Harrison et al is functionally equivalent to a hierarchical tree traversal since the two processes achieve the same goal and reach the same result, i.e., the identification of the appropriate person to fulfill a request. Since the two are functionally equivalent, it would have been obvious to one of ordinary skill to employ a database query tool such as this in order to identify the appropriate person to fill the request.

As per claim 49, Harrison et al teaches receiving a service request from a service requestor (column 3, lines 11-65 – subscribers submit a service request using e-mail, telephone, or several other means of communication), identifying, with the system, a technician by successively reviewing increasingly more general descriptions until an appropriate technician is identified; and relaying at least part of the service request from the service requestor to the technician identified (column 4, lines 28-37 – service request is entered; column 6, lines 6-16 – automatic dispatch of service requests to available technicians). Harrison et al teaches colored graphical representations of the service requests indicating different alerts, but does not explicitly teach the service request having a specified level of urgency; comparing with the property management system the specified level of urgency against contact preferences previously specified by the recipient. However, Jones teaches each trouble ticket (service request) has an associated escalation level wherein based on the escalation level appropriate personnel are notified. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the escalation levels (reflecting urgency) of Jones into Harrison et al as a way to increase response time for situations wherein immediate action must be taken. The inclusion of urgency levels would ensure tenant satisfaction and also would ensure emergency situations are taken care of promptly. While the combination of Harrison et al and Jones does

not explicitly teach the system being associated with property management these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per claim 50, Harrison et al teaches the service requester is a subscriber, but does not expressly teach the requestor is a tenant; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per claims 51-53, Harrison et al teaches the recipient is a technician, but does not expressly teach the recipients recited in claims 51-53; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed

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invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106.

As per claim 54, Harrison et al does not explicitly teach the specified level of urgency is selected from a plurality of levels. However, Jones teaches each trouble ticket (service request) has an associated escalation level wherein based on the escalation level appropriate personnel are notified. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the escalation levels (reflecting urgency) of Jones into the Harrison et al system as a way to increase response time for situations wherein immediate action must be taken. The inclusion of urgency levels would ensure tenant satisfaction and also would ensure emergency situations are taken care of promptly.

As per claim 55, Harrison et al does not explicitly teach the specified level of urgency is selected from low, medium, high and emergency levels. However, Jones teaches each trouble ticket (service request) has an associated escalation level wherein based on the escalation level appropriate personnel are notified and also numerical escalation levels (inherently reflecting low to intermediate to emergency levels). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the escalation levels (reflecting urgency) of Jones into the Harrison et al as a way to increase response time for situations wherein immediate action must be taken. The inclusion of urgency levels would ensure tenant satisfaction and also would ensure emergency situations are taken care of promptly.

As per claim 56, Harrison et al teaches at least part of the service request is formatted with a message template selected based at least in part on information associated with the service

request (column 3, lines 49-55 – subscriber submits a service request by navigating a series of menus to enter pertinent information about the service request so as to be routed to the appropriate service representative).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/jl/  
6/30/08  
/Jonathan G. Sterrett/  
Primary Examiner, Art Unit 3623

